

REMARKS

By the present amendments, Claims 37-38, 42-43, and 47-48 remain pending. Claims 37, 42, and 47 have been amended. New dependent Claims 51-63 have been added. Claims 36, 39-41, 44-46, and 49-50 were previously cancelled during the Applicants' Appeal that is being withdrawn pursuant to filing the present Response and Request for Continued Examination. Applicants respectfully submit that no new matter has been added by the foregoing amendments. In view of the amendments and remarks, Applicants respectfully assert that the rejections set forth in the Office Action mailed on June 24, 2004 are now made moot and that the pending claims are in condition for allowance.

Claim Rejections Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected Claims 36-40 under 35 U.S.C. § 101 because the claimed invention was purportedly directed to non-statutory subject matter. In particular, the Examiner cites *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978) and *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPaApp&Int 2001) for the proposition that 35 U.S.C. § 101 includes a "technological arts" test. Claims 34-41 and 49-52 allegedly did not satisfy this purported "technological arts" test. Applicants respectfully submit that in view of *Ex parte Lundgren* and the USPTO's new Guidelines for Subject Matter Eligibility, the Office Action's rejections of Claims 34-41 and 49-52 under the purported "technological arts" test of 35 U.S.C. § 101 are now moot.

In particular, the Board of Patent Appeals and Interferences in *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005), expressly rejected the existence of this separate "technological arts" test relied upon by the Office Action. Indeed, after reviewing *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970); *In re Toma*, and *Ex parte Bowman*, the Board of Patent Appeals and Interferences expressly stated in *Ex parte Lundgren*:

Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to propose to create one. Therefore, it is apparent that the examiner's rejection can not be sustained. (*see* page 9)

As a result of *Ex parte Lundgren*, the USPTO issued new Guidelines for Subject Matter Eligibility on (see OG Notice of November 22, 2005, available at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>). Indeed, the new Guidelines indicate that:

USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter. There is no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas.

Accordingly, Applicants respectfully submit that in view of *Ex parte Lundgren* and the USPTO's new Guidelines for Subject Matter Eligibility, the Office Action's rejections of Claims 36-40 under 35 U.S.C. § 101 are now moot. Additionally, the Applicants note that, during the Appeal that is currently being withdrawn, the Examiner dropped his rejections to Claims 36-40 under 35 U.S.C. § 101 following an Order Remanding to the Examiner from the Board of Patent Appeals and Interferences. It is respectfully submitted that the rejections of Claims 36-40 under 35 U.S.C. § 101 are moot for at least the reasons stated above.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 36-50 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,220,501 to Lawlor et al. ("Lawlor") in view of an article entitled "4-in-1 Accounting: The Basics from Real World" that was written by White et al. ("White").

Lawlor is directed to a system that provides banking type financial transactions, including payment of bills, via remote data terminals that communicate with a central computer using the ATM network (column 1, lines 6-16). To use billpaying features, customers provide a service provider associated with the central computer a list of payees in advance (column 10, lines 66-68). The customer may then instruct the service provider to pay bills via the remote data terminal (column 11, lines 16-21 and column 33, lines 3-23). In order to pay a bill, the service provider first debits the customer's account via the ATM network at his/her network bank in order to provide an automatic account inquiry/balance check and ensure that the customer does

not overdraw his bank account (column 11, lines 43-59, column 33, lines 37-50, and column 34, lines 35-40). The service provider then sends a payment to the payee via either an electronic method, such as through the Automated Clearing House (ACH) system or through the ATM network (column 11, lines 61-67) or, via a paper check (column 11, lines 55-60).

White discusses an accounting system for small businesses that assists users in tracking accounts payable, accounts receivable, and payroll (page 1, lines 1-5). Information may be maintained in a vendor file for each of the user's vendors in order to process invoices due to each vendor and to record and process disbursements made to each vendor (page 4, lines 18-23). The accounts payable module of White allows a vendor to be added to the vendor file on the fly if an invoice is entered for a vendor that is not yet established in the vendor file (page 4, lines 40-50).

Although Applicants contend that the combination of White and Lawlor is improper because White is not analogous art to the present invention, in order to expedite the prosecution of the present Application, Applicants have amended independent claims 37, 42, and 47 to more fully distinguish the present invention from the prior art. Applicants respectfully assert the outstanding rejection of Claims 37-48 is traversed in view of the amended claims. Specifically, each of the independent claims have been amended to recite that a merchant credit limit is associated with at least one of the one or more merchants added to the merchant database. As discussed on at least page 12, lines 9-12, and page 14, lines 14-18 of the Specification, a transaction may be compared to a merchant credit limit to determine if the transaction amount exceeds the payment limit for the particular merchant. Because the present invention comprises risk-based systems and methods (i.e., the funds are not required to be present in the account at the time the payment request is processed), such edits are performed to minimize risk.

Applicants respectfully assert that neither Lawlor nor White discloses, teaches and/or suggests this limitation. In particular, Lawlor fails to disclose any risk analysis or equivalent payment analysis to determine if a transaction amount exceeds a limit associated with the merchant. In fact, because Lawlor discloses a good funds transaction system where a debit is made only if funds are available (see, e.g., column 11, lines 22-52, column 33, lines 23-25, and column 34, lines 35-36), Lawlor teaches away from the use of a payment limit associated with a merchant. Similarly, White fails to provide any teaching or suggestion of a merchant limit as

White is directed to accounting software that balances accounts payable and account receivable, not to a bill payment system.

For at least the above reasons, Applicants respectfully assert that amended independent claims 37, 42, and 47 are allowable over the recited art and are in condition for allowance. Additionally, dependent claims 38, 43, 48, and 51-63 are allowable as a matter of law as depending from an allowable base claim, notwithstanding their independent recitations of patentable features.

Patentability of New Dependent Claims

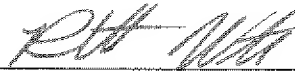
Applicants respectfully submit that new dependent Claims 55, 59, and 63 are not only patentable as being dependent from an allowable independent claim, but also for reciting patentable features. Each of these claims specifically recites the step of “determining if an account number associated with the consumer and the at least one of the one or more merchants conforms to an account scheme associated with the at least one of the one or more merchants.” Neither Lawlor nor White teach or suggest determining if an account number conforms to an account scheme associated with a merchant. Accordingly, it is respectfully submitted that dependent Claims 55, 59, and 63 recite patentable subject matter and are allowable over the prior art cited by the Examiner.

In re: Kight, et al.
Appl. No.: 09/540,011
Filed: March 31, 2000

CONCLUSION

The Applicants believe they have responded to each matter raised by the Examiner. Allowance of the claims is respectfully solicited. It is not believed that extensions of time or fees for addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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